

Remarks:

Claims 1-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,594,485, issued to Ezaki in view of U.S. Patent No. 6,393,113 to Karras. Claims 1 and 9 are amended. New claim 21 is added. No new matter has been added. Support for the amended language is provided in the specification and the drawings.

The Examiner contends that it would have been obvious to one of ordinary skill in the art, at the time of filing of Ezaki, to generate and transmit a ring back tone in the manner claimed herein. This rejection is respectfully traversed.

Ezaki is directed to a communication system for reconnecting a first mobile terminal to a second mobile terminal in a cellular communication network, when a line between one of the mobile terminals and a base station to which the mobile terminal is connected is abruptly interrupted and the line does not return to a normal state. According to Ezaki, both terminals communicate over the same type of communication network (i.e., a cellular communication network). Furthermore, col. 11, lns. 60-67, to which the Examiner refers particularly suggests that the ring back tone is generated by a “base station.”

In contrast, the invention, as recited in claim 1, is directed to solving a problem of different nature. That is, the claimed invention provides a solution to generating ring back tone in a scenario where two terminals communicate over two different types of communication networks. More specifically, claim 1 recites a scenario where a terminal receiving a call communicates over a VOIP network, and the terminal generating the call communicates over PSTN, wherein the VOIP and PSTN networks are connected by a trunk gateway, such that upon receiving the call, the VOIP terminal independently generates a ring back tone (i.e., “without any help from a PSTN switchboard or access gateway.”) See paragraph [0052] of the specification.

MPEP §2143 provides:

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Respectfully, Ezaki fails to teach, suggest or disclose a method to generate a ring back tone as recited in amended claim 1, wherein the first terminal communicates over a voice over internet protocol (VOIP) network and the second terminal communicates over public switched telephone network (PSTN), wherein the VOIP and the PSTN networks are connected by way of a trunk gateway. Furthermore, Ezaki expressly teaches away from the method recited in claim 1 by suggesting that the ring back tone is generated by and transmitted from a *first radio base*. In contrast, claim 1 as amended recites that the ring back tone is generated by the *first terminal* (i.e., a terminal communicating over an internet protocol, which is receiving a call). Since Ezaki directly teaches away from the claimed invention, a person of ordinary skill would not have been motivated to modify Ezaki in the direction of the claimed invention or to combine it with another reference.

The Applicant has reviewed Karras and it is respectfully submitted that Karras fails to cure the deficiencies of Ezaki. Particularly, the two networks (“Teknoville” and “Bell City”) noted in FIG. 1 to which the Examiner refers to as disclosed in Col. 4, lines 10-17 of Karras, are the same type of network (e.g., a PSTN). As such, Karras also teaches away from the method recited in claim 1, whereas the two terminals communicate over two different types of networks. Therefore, it would be unreasonable for the Examiner to suggest the two cited references may be combined to teach the claimed invention.

While the suggestion to modify this reference may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant’s disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. In re Geiger, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

For the above reasons, Ezaki does not teach or suggest the invention as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. Claims 2-8 depend from claim 1 and should be in condition for allowance by the virtue of their dependence on an allowable base claim. Amended claims 9 and 21 substantially incorporate the elements of claim 1; therefore, claims 9, 17 and 21 and claims 10-16 depending from claim 9 should also be in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

¹ ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

² "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789 2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

Lee, Hong, Degerman, Kang & Schmadeka

Date: January 18, 2008

By: _____



Lew Edward V. Macapagal

Registration No. 55,416

Attorney for Applicant